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Election

PATENT
BBA 1-023

E. J. Panton

10/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application Of:
Randall G. Richards, Keith A. Jones,
and Colin Berrido

Group Art Unit: 1761

Serial No.: 10/002,972

Examiner: Robert A. Madsen

Filed: 26 October 2001

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For: **COMPARTMENTALIZED STORAGE SYSTEM FOR
TEMPORARILY STORING AND SUBSEQUENTLY MIXING AT LEAST
TWO DIFFERENT SUBSTANCES**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE PURSUANT TO 37 C.F.R. SECTION 1.143

Sir:

This Response pursuant to 37 C.F.R. Section 1.143 is in reply to the Examiner's Action dated 18 July 2003 in the above-identified patent application in which claims 1-36 were subjected to a restriction requirement. A Response to the outstanding Office Action is due 18 August 2003. Accordingly, this Response is being timely filed.

Applicants request that the Examiner consider the following Response and withdraw the pending restriction requirement.

CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. SECTION 1.8

I hereby certify that this correspondence is being deposited, pursuant to 37 C.F.R. Section 1.8, with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11 of August, 2003.

By Richard R. Muccino

Richard R. Muccino

date

Reg. no. 32,538

Attorney for Applicant(s)

RESPONSE

The Examiner has required restriction of the claims in the present application pursuant to 35 U.S.C. Section 121. Specifically, the Examiner states that restriction to one of the following groups is required.

I. Claims 1-19, drawn to a compartmentalized mixing container utilizing a frangible seal, classified in class 206, subclass 222.

II. Claim 20-32, drawn to a compartmentalized mixing food container, classified in class 426, subclass 120.

III. Claims 33-34, drawn to a method of using a compartmentalized mixing container utilizing a frangible seal, class 366, subclass 130.

IV. Claim 35-36, drawn to a method of using a compartmentalized mixing food container utilizing a frangible seal classified in class 426, subclass 392. 2.

The Examiner states that inventions Group I and Group II are distinct, each from the other because inventions I and II are related as combination and subcombination. The Examiner states that the inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. In the instant case, the Examiner states that the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require edible substances and the subcombination has separate utility such as a non-mixing device comprising two edible substances wherein the common wall does not have to be removed and the substances do not have to be mixed for consumption.

The Examiner states that both inventions I and II are related to inventions III and IV as products and processes of their use. The Examiner states that inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. In the instant case, the Examiner argues that the products as claimed can be used in a materially different process of using that product, for example, the compartmentalized containers could be used as a non-mixing devices wherein the (1) common wall does not have to be removed to

access the substances (2) the materials do not have to mixed, and (3) one does not have to remove the other substance by going through the common wall.

The Examiner states that inventions III and IV are unrelated, and that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case the Examiner argues that different inventions have different modes of operation, for example invention III mixes a sorbing substrate with two substances, while invention IV mixes two edible substances without a sorbing substrate.

The Examiner concludes that these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and therefore restriction for examination purposes as indicated is proper.

Applicants elect to prosecute the claims of Group I, claims 1-19.
Applicants traverse the Examiner's restriction requirements.

Applicants' invention, as defined in claims 1-19, provides a compartmentalized storage system for temporarily storing and subsequently mixing at least two different substances comprising (a) a first storing compartment having a front and a back and a plurality of sides, defining a first cavity portion, wherein a solid sorbing substrate and a first substance are stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second substance is stored in the second storing compartment; wherein the first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments, whereby upon by applying force to the frangible seal, the seal will break and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment.

Applicants' invention, as defined in claims 20-32, provides a compartmentalized storage system for temporarily storing and subsequently mixing at least two different edible substances comprising (a) a first storing compartment having a front and a back, a plurality of sides, defining a first cavity portion,

wherein a first edible substance is stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second edible substance is stored in the second storing compartment; wherein the first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments, whereby upon by applying force to the frangible seal, the seal will break and thereby allow the second edible substance in the second storing compartment to be mixed with the first edible substance in the first storing compartment.

Applicants' invention, as defined in claims 33-34, provides a method for using a compartmentalized storage system to temporarily store and subsequently mix at least two different substances comprising the steps of (A) providing a compartmentalized storage system comprising (a) a first storing compartment having a front and a back, a plurality of sides, defining a first cavity portion, wherein a solid sorbing substrate and a first substance are stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second substance is stored in the second storing compartment; wherein the first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments, whereby upon by applying force to the frangible seal, the seal will break and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment; (B) applying force to the frangible seal to break the seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment; (C) applying force to the tearable seal to break the seal; and (D) removing the solid sorbing substrate, mixed with the first substance and the second substance, through the broken tearable seal in the first storing compartment.

Applicants' invention, as defined in claims 35-36, provides a method for using a compartmentalized storage system to temporarily store and subsequently mix at least two different edible substances comprising the steps of (A) providing a compartmentalized storage system for temporarily storing and subsequently mixing

at least two different edible substances comprising (a) a first storing compartment having a front and a back, a plurality of sides, defining a first cavity portion, wherein a first edible substance is stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second edible substance is stored in the second storing compartment; wherein the first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments, whereby upon by applying force to the frangible seal, the seal will break and thereby allow the second edible substance in the second storing compartment to be mixed with the first edible substance in the first storing compartment; (B) applying force to the frangible seal to break the seal and thereby allow the second edible substance in the second storing compartment to be mixed with the first edible substance in the first storing compartment; (C) applying force to the tearable seal to break the seal; and (D) removing the first edible substance mixed with the second edible substance through the broken tearable seal in the first storing compartment.

M.P.E.P. Section 803 states that there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent ... or distinct as claimed; and
- (2) There must be a serious burden on the Examiner if restriction is not required...(emphasis added, citations omitted).


If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions, M.P.E.P. Section 803. Applicants contend that the search and examination of the present application can be made without serious burden and request the Examiner to examine it on the merits.

Hence, applicants' product claims and method claims for preparing and using the product are not distinct inventions and restriction is not proper. In view of the foregoing Response, applicants request reconsideration pursuant to 37 C.F.R. Section 1.143 of the Examiner's position requiring restriction so that all of the claims can be examined in this single application thus helping to expedite prosecution of this application.

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Applicants request the Examiner to telephone the undersigned attorney should the Examiner have any questions or comments which might be most expeditiously handled by a telephone conference. Applicants' attorney authorizes the Examiner to charge Deposit Account 13-4822 if there are any additional charges in connection with this Response.

Respectfully submitted,
Randall G. Richards, Keith A. Jones, and Colin Berrido

By 
Richard R. Muccino
Reg. No. 32,538
Attorney for Applicant(s)

Direct communications to:
Richard R. Muccino
758 Springfield Avenue
Summit, New Jersey 07901
voice (908) 273-4988
fax (908) 273-4679